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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/848,773	05/19/2004	Sean T. Dycus	2727 CON	7228

7590
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04/13/2007

EXAMINER

PEFFLEY, MICHAEL F

ART UNIT

PAPER NUMBER

3739

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/13/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/848,773

Applicant(s)

DYCUS ET AL.

Examiner

Michael Peffley

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 January 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 5-19-04 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 12/4/06: 1/16/07.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____.
- ☐ Notice of Informal Patent Application
- ☐ Other: _____.

Applicant's amendments and comments, received January 16, 2007, have been fully considered by the examiner. The following is a complete response to the January 16, 2007 communication.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Specification

The disclosure is objected to because of the following informalities: the first sentence of the specification should be amended to provide the most current status (i.e. US Patent No.) for the related application.

Appropriate correction is required.

Terminal Disclaimer

The terminal disclaimer filed on January 16, 2007 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of US Application No. 10/849,432 has been reviewed and is NOT accepted.

An attorney or agent, not of record, is not authorized to sign a terminal disclaimer in the capacity as an attorney or agent acting in a representative capacity as provided by 37 CFR 1.34 (a). See 37 CFR 1.321(b) and/or (c).

Claim Rejections - 35 USC § 103

Claims 1 and 2 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yates (H1,904) in view of the teaching of Rydell et al (5,258,006).

As asserted in the previous Office action, Yates et al disclose an endoscopic device for sealing and cutting tissue whereby the jaws create a desired gap (e.g. Figure

6). Yates also discloses the particular closure pressure as recited in the instant claims (col. 4, lines 25-35). Yates, however, fails to disclose channels extending through the endoscope for providing electrical conductors for connection to the jaw members.

The examiner maintains that various means for actuating and providing energy to RF forceps are generally well known in the art. That is, the use of a slidable sheath to cam over the jaws to effect closure is one well known actuating mechanism, as is the use of an actuating rod with separately providing conductors. The various linkages for effecting movement of the jaws (e.g. camming surfaces, clevis pins, four bar linkages, etc.) are also generally well known and found throughout the art.

With regard to the instant application claims, it is the examiner's position that it would have been an obvious modification to have provided the Yates device with any well known actuation and electrical connection means as is demonstrated in the art. To that end, Rydell et al disclose a bipolar forceps device that also uses an outer tube (11) as a camming surface for closing the jaws. In particular, Rydell et al teach that the leads (13) for the electrosurgical jaws may be provided in channels (23) within the elongate member. This provides a direct connection between the leads and the jaw members and does not require the camming surface to make an electrical connection.

To have provided the Yates device with electrical leads extending through channels within the endoscopic portion of the device to make a direct electrical connection with each jaw member is deemed to be an obvious design modification for one of ordinary skill in the art since Rydell et al teach that such a connection is known in an analogous device.

Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yates (H1,904) in view of the teaching of Rydell et al (5,258,006) and further in view of the teaching of Chen et al (6,358,249).

The combination of the Yates and Rydell et al teachings has been addressed above. Neither of these references specifically disclose the use of a four bar linkage to effect closure of the jaw members.

As asserted previously, the examiner maintains that the use of various well known connection and actuation means are generally known throughout the endoscopic forceps art.

Chen et al disclose another RF forceps device for cutting and sealing tissue, and provides compression ridges on the jaws of the forceps similar to the Yates device. In particular, Chen et al specifically teach that it is known to use four bar linkages with an actuation rod (Figure 15) to provide opening and closing of the forceps jaws. Additionally, it is noted that the electrical leads of Chen et al are provided through channels in the endoscope portion for direct connection to the jaw members.

To have provided the Yates device, as modified by the teaching of Rydell et al, with a four bar linkage assembly to effect closure of the jaw members would have been an obvious design consideration for one of ordinary skill in the art since Chen et al fairly teach the known use of such a closure mechanism.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory

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obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-3 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 and 2 of U.S. Patent No. 10/849,432 in view of the teaching of Eggers et al (5,484,436). The only difference between the two sets of claims is the type of instrument. The instant application claims are drawn to an endoscopic instrument, and the '432 application claims are drawn to an open-procedure instrument. Eggers et al fairly teach that it is generally known to provide such a device in either open-procedure (Figure 1) or endoscopic procedure (Figure 2) form to use the device in a variety of situations. To have provided the claims in either form is deemed an obvious design expedient in view of the teaching of Eggers et al. The use of channels for providing conductors to the electrodes is also deemed an obvious consideration for one of ordinary skill in the art.

Response to Arguments

Applicant's arguments with respect to claims 1-3 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

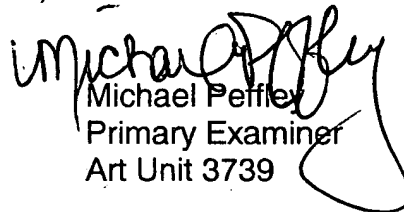
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Peffley whose telephone number is (571) 272-4770. The examiner can normally be reached on Mon-Fri from 6am-3pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Michael Peffley
Primary Examiner
Art Unit 3739

mp
April 10, 2007